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REMARKS

Claims 8-11, 13, 14, 20, and 29-37 are currently pending. Claims 1-7, 12, 18, 23, and 26-28 have been cancelled without prejudice or disclaimer. Claim 20 has been amended with subject matter from page 7, lines 8-20, of the application as filed. New claims 29-37 have been added to enhance the scope of Applicant's patent coverage and are supported by page 5, line 5, through page 7, line 26, and elsewhere in the original disclosure, including the original claims. It is respectfully submitted that no new matter has been added.

Regarding Certain Amendments to the Claims

The following commentary presented in an earlier response is relevant to the currently pending claims.

The Patent Office on page 10 of the Final Office Action dated October 31 2007 asserted that phrases such as "arranged to enable," "to provide," "providing," and "operable ... to" are considered intended use because these phrases merely describe a capability of the claimed invention and are not positively recited. No case law was cited to support the Patent Office position. Only MPEP section 2111.04 was cited for support by the Patent Office. MPEP Section 2111.04 recites as follows:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of

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the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*<

It is clear that MPEP Section 2111.04 is not making a blanket statement that a phrase such as "adapted to" is unacceptable. It merely states that one must consider the specific facts of the case.

The role of the Patent Office is to promote the useful arts. It does this by granting limited monopolies to exclude others from making or practicing an invention. In order to permit a patent owner to enforce his rights to exclude others, such as by pursuing infringers, enforceable claims need to be issued in a patent grant. The noted phrase, in a patent, would permit the patent owner to better pursue an infringer; for example, someone who is importing CDs or devices covered by the patent claims but for the CD or device being in operation to perform claimed functions and/or method steps.

Applicant believes that all phrases such as "configured to," "arranged to," and "to provide" as had been recited in the present claims cannot reasonably be considered "intended use."

Rejection of Claims 1-9, 12-21, 23, and 24 by Apfel in view of McIntyre

The Patent Office rejected claims 1-9, 12-14, 18, 20, 23, and 26-28 under 35 U.S.C. 103(a) as being unpatentable over Apfel, U.S. Patent No. 6,973,299, in view of McIntyre, U.S. Patent No. 7,111,317.

There are three currently pending independent claims: claims 20, 29, and 30.

Claim 20 recites as follows:

A computer readable medium encoded with a computer program comprising: program instructions for controlling an electronic device, the electronic device having a digital camera and a user input device, which program instructions when loaded into a processor, provide: a database software application; a camera control software application that is separate from the database software application; and an image viewing

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software application that is separate from the camera control software application and the database software application, wherein the database software application provides a user interface that enables a user to access personal data organized as a plurality of contacts entries in a database, where each contacts entry is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the camera control software application provides a user interface that enables the user to control the electronic device using the user input device to capture an image via the digital camera and to immediately and automatically presents a user selectable option, on capturing an image, for entering the database software application and using the captured image as an image field of a contacts entry of the database, and a user selectable option to access the captured image through the image viewing software application.

Claim 29 recites as follows:

A method comprising: capturing an image via a digital camera by a selection of an option presented on a user interface provided by a camera control software application; immediately and automatically upon capturing the image, providing a user-selectable option through the user interface for entering the captured image as an image field for a contacts entry maintained by a database software application and providing a user-selectable option through the user interface to cause a image viewing software application to access the captured image; and upon selecting a user-selectable option for entering the captured image as an image field for the contacts entry, causing the database software application to save the captured image as an image field for the contacts entry.

Claim 30 recites as follows:

An apparatus comprising: a camera control software application; a database software application; an image viewing software application; a digital camera; an input including soft keys; a memory configured to store the database, camera control software application, the database software application, and the image viewing software application; a display configured to provide a user interface; and a processor configured to control the digital camera and the display, configured to access the memory, configured to receive information through the input, and configured to execute the camera, database, and image viewing software applications retrieved from the memory, wherein the camera control software application is configured to enable a user to capture an image via the digital camera through an option on the user interface and,

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immediately and automatically after capturing the image, to present on the user interface a plurality of user selectable options including an option to add the captured image to a database that is accessible by the database software application and including an option to invoke the image viewing software application to access the captured image, wherein the user selectable options are selectable by the user through corresponding ones of the soft keys.

The Patent Office asserted as follows:

Apfel does not explicitly teach a digital camera; and a camera control application that enables the user to control the device using the user input device to capture an image via the digital camera and, immediately upon capturing an image, presents a user selectable option for entering the database application.

McIntyre teaches an electronic device (see Abstract) comprising a digital camera (see column 3, line 38, "image capture device"); and a camera control application arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to present a user selectable option, on capturing an image, for entering the database application (see columns 12-13, spanning paragraph, particularly column 12, lines 61-62, "after taking a picture").

Therefore, it would have been obvious to one of ordinary skill in the relevant art at the time the invention was made to have modified Apfel by the teaching of McIntyre because "[f]orms of communication for the one or more contacts include [...] multimedia message service (MMS)" (see Apfel, column 3, lines 52-55) and MMS messages are a well-known feature in camera phones. Furthermore, McIntyre anticipates the use of cellular phones at line 17 of column 22.

Apfel discloses a mobile phone that stores contact information for multiple forms of mobile phone communication with the contacts (abstract). In Apfel, user information 250B may include a picture or graphic that the contact wishes to publish to represent himself or herself (column 5, lines 53-56). Apfel discloses that changed contact information may include a new email address, phone number, picture representation, etc., for contact 230A at PC 270A (column 7, lines 51-53). Apfel's mobile phone, in Figure 3, is shown to have a display 310 and directional button 364 but clearly does not have an image capturing portion, such as a lens. Although picture representations may be changed in contact information for a mobile phone,

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Apfel does not disclose or suggest providing a user selectable option, upon capturing an image, to enter an application, such as a database application.

McIntyre discloses “A system and method for obtaining photographic products and/or services and for the sharing of digital images without the need of a computer. In particular a cable set top box and cable communication network is used for communication with third parties, including image service providers” (abstract). McIntyre discloses capturing an image and associating text with it. The image may be printed out at a later time with the text appear on the image. McIntyre does not disclose or suggest providing a user selectable option, upon capturing an image, to enter an application, such as a database application.

Furthermore, Apfel is concerned with updating a contacts list from a mobile telephone, whereas McIntyre is concerned with providing photographic goods and services (e.g., column 22, lines 5-8). Whereas Apfel discloses an image associated with a contact in a database, McIntyre is directed to the printing of images which may also contain text. It is difficult to see the relevancy of a method and system for providing image goods and/or services to a customer, as disclosed by McIntyre, to a method and system for providing a unified contact list for a mobile phone user, as disclosed by Apfel and it is doubtful that one of ordinary skill in the art would look to McIntyre to modify Apfel.

Without admitting implicitly or explicitly any need to amend, to advance the claims, Applicant has amended the claims.

Apfel and McIntyre, alone or in combination, do not disclose or suggest the claimed invention. For example, Apfel and McIntyre, alone or in combination, do not disclose or suggest a camera control software application, a database software application, and an image viewing software application in an apparatus, method, or computer readable medium. As another example, these two references do not disclose or suggest, alone or in combination, “an option to add the captured image to a database that is accessible by the database software application and including an option to invoke the image viewing software application to access the captured image,” as recited in claim 30, and similarly in claims 20 and 29.

Thus, claims 8-11, 13, 14, 20, and 29-37 are allowable over Apfel in view of McIntyre.

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Rejection of Claims 10 and 11 by Apfel in view of Morita

The Patent Office rejected claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Apfel as applied to claims 9 and 1 above, respectively, and further in view of Morita, U.S. Patent No. 6,766,018.

As claims 10 and 11 have been cancelled, Applicant believes that the 35 U.S.C. 103(a) rejection is moot.

Comments

Applicant requests that the Patent Office point out by line number and column number and by part number where the each and every claim limitation of a rejected claim is to be found.

MPEP Section 2106 states “**when evaluating the scope of a claim, every limitation in the claim must be considered**. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)”

The Patent Office is respectfully requested to reconsider and withdraw the rejections of the claims 1-14, 18, 20, 20, 23, and 26-28 under 35 U.S.C. 103(a) based on Apfel in view of McIntyre, whether or not further in view of Morita, and to allow all of the pending claims 8-11, 13, 14, 20, and 29-37 as now presented for examination. An early notification of the allowability of claims 8-11, 13, 14, 20, and 29-37 is earnestly solicited.

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Respectfully submitted:

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August 7, 2008 Julie Bragg
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